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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,246	04/16/2004	Kari Sainio	037145-3001	9623
30542 7590 02/19/2008 FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278			EXAMINER CHU, WUTCHUNG	
			ART UNIT 2619	PAPER NUMBER
			MAIL DATE 02/19/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,246

Applicant(s)

SAINIO, KARI

Examiner

Wutchung Chu

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 is/are allowed.
- 6) ☒ Claim(s) 1,2,7-14, 19-24,27,28 and 33-38 is/are rejected.
- 7) ☒ Claim(s) 3-6,15-18 and 29-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/16/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 13-24 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 13 and 26, the claim is "program" per se is not a "physical thing" and does not fall into one of the four statutory classes of invention: process, machine, manufacture, or composition of matter. Claims 14-26 are rejected as they depend on claim 13.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 10-12, 13-14, 22-24, 27-28, and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Brewer (US2005/0041625).

5. **Regarding claim 1**, Brewer discloses Image method and apparatus for providing media communication setup strategy in a communication network **(see paragraph 5)** comprising:

- establishing a communication session between a sending device and one or more receiving devices **(see paragraph 5 receiving a request from an originator for media communication to at least one target and figure 2)**;
- opening a common channel for transmission by said sending device of a notification of availability of image data **(see paragraph 25 signal channel and paragraph 26)**; and
- opening one or more data channels **(see paragraph 25 media traffic channel and paragraphs 52 and 67)** for transmission of at least a portion of said image data to said receiving devices **(see paragraph 75)**, each data channel being dedicated to one of said receiving devices **(see paragraph 44 the originator who wishes to initiate the communication session for sending media may select one or more target users therefore a communication session can be dedicated to one target users)**.

Regarding claims 2, 14 and 28, Brewer teaches the step of establishing a communication session includes establishing a session using Session Initiation Protocol (SIP) **(see paragraph 20 SIP)**.

Regarding claims 10, 22 and 36, Brewer teaches further comprising:
transmitting image data **(see paragraph 23 image)** to each of said receiving devices in accordance with parameters specified by each receiving device **(see paragraph 35 the targets have a valid registration)**.

Regarding claims 11, 23 and 37, Brewer teaches the sending device includes an image data server **(see paragraph 23 image and paragraph 35 originator permission to deliver media)**.

Regarding claims 12, 24 and 38, Brewer teaches at least one of said sending device and said receiving devices is a wireless device **(see paragraph 5 wireless communication)**.

Regarding claim 13, Brewer teaches a program product, comprising machine readable program code **(see paragraph 79 programmable logic device)** for causing a machine to perform the following method steps:

- establishing a communication session between a sending device and one or more receiving devices **(see paragraph 5 receiving a request from an originator for media communication to at least one target and figure 2)**;
- opening a common channel for transmission by said sending device of a notification of availability of image data **(see paragraph 25 signal channel and paragraph 26)**; and

- opening one or more data channels for transmission of at least a portion of said image data to said receiving devices (**see paragraph 25 media traffic channel**), each data channel being dedicated to one of said receiving devices (**see paragraph 44 the originator who wishes to initiate the communication session for sending media may select one or more target users therefore a communication session can be dedicated to one target users**).

Note: the phrase “capable of” of “adapted to” recited in claim 27, 29, and 35-36 do not positively support claim limitations, therefore, the limitation after these phrases will not be considered as claimed limitations. However, the cited reference teaches the limitations (see rejection).

Regarding claim 27, Brewer teaches system for transferring image data, comprising:

- a sending device adapted to establishing a communication session with one or more receiving devices (**see paragraph 5 receiving a request from an originator for media communication to at least one target and figure 2**); and
- an image data server (**see paragraph 23 image and figure 2 group communication server**) adapted to respond to requests for image data from said one or more receiving devices (**see paragraph 75 and figure 7 ref730 sends a “media grant” message**);

- wherein at least one of said sending device and said image data server is adapted to open one or more data channels **(see paragraph 52 and 67)** for transmission of image data **(see paragraph 23 image)** to said receiving devices, each data channel being dedicated to one of said receiving devices **(see paragraph 44 the originator who wishes to initiate the communication session for sending media may select one or more target users therefore a communication session can be dedicated to one target users)**.

Claim Rejections - 35 USC § 103

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7-9, 19-21, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer.

Regarding claims 7, 19 and 33, Brewer teaches the traffic channels of the target CDs are up, and at least one target has accepted to receive media from the originator (**see Brewer paragraphs 52 and 67**), but does not explicitly disclose a dedicated data channel. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include dedicated channel, because dedicating channel, as in Brewer, is a method for have multiple traffic channels to target CDs.

Regarding claims 8, 20 and 34, Brewer teaches the request from each of the receiving devices includes specification of parameters relating to image data (**see paragraph 23 image**) to be transferred to said receiving device (**see paragraph 35 the targets have a valid registration**).

Regarding claims 9, 21 and 35, Brewer teaches further comprising: transmitting image data (**see paragraph 23 image**) to each of said receiving devices in accordance with parameters specified by each receiving device (**see paragraph 35 originator permission to deliver media**).

Allowable Subject Matter

9. Claims 3-6, 15-18, and 29-32 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claim 25 is allowed because the cited prior art does not teach the combinational limitations of: establishing an SIP session between a sending device and at least one

receiving device; and initiating an image transfer session using BEEP channels within said SIP session, said image transfer including transfer of JPIP image data.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Black (US2007/01273074)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wutchung Chu whose telephone number is 571 270

1411. The examiner can normally be reached on Monday - Friday 1000 - 1500EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan D. Orgad can be reached on 571 272 7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WC/
Wutchung Chu

EDAN D. ORGAD
SUPERVISORY PATENT EXAMINER

